



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/708,247

02/19/2004

Robert M. Allen

1516.01

2246

21901 7590 07/25/2008

SMITH HOPEN, PA  
180 PINE AVENUE NORTH  
OLDSMAR, FL 34677

EXAMINER

OYEBISI, OJO O

ART UNIT

PAPER NUMBER

3696

MAIL DATE

DELIVERY MODE

07/25/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/708,247	<b>Applicant(s)</b> ALLEN ET AL.	
	<b>Examiner</b> OJO O. OYEBISI	<b>Art Unit</b> 3696	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 April 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

**In the amendment filed on 04/14/08, the following have occurred: claims 7 and 17 have been amended, and claims 1-17 are currently pending.**

#### *Claim Rejections - 35 USC §101*

1. 35 U.S.C. §101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-17 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.

3. Based on Supreme Court precedent (*Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions, §101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (the Supreme Court recognized that this test is not necessarily fixed or permanent and may evolve with technological advances. *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)).

4. If neither of these requirements is met by the claim(s), the method is not a patent eligible process under 35 U.S.C. §101.

5. In this particular case, regarding the first test, in performing the steps of the claimed subject matter, there is no requirement that a machine be used, thus the claims are not considered

Art Unit: 3696

sufficiently tied to another statutory class. Regarding the second test, since the claimed subject matter may be performed using only human intelligence, the steps do not sufficiently transform the underlying subject matter to be statutory. Thus, to qualify as a 101 statutory method, the claim should positively recite the other statutory class (the thing or product) to which it is tied. For example, a method claim that is sufficiently tied to another statutory class (i.e., product) would be recited as follow: authorizing, via a processor, the predetermined limit amount.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Wells et al (Wells hereinafter, US PAT: 6901387).

Re claim 1. Wells discloses a method of paying a merchant for a claim service provided to a claimant, the method comprising the steps of: receiving a request from a merchant for a payment associated with a claim (see fig.7 element 702, i.e., selection of merchant and item to be purchase is inherently followed by a request from a merchant for a payment); generating a claim identifier (see fig.7 element 704) ; generating a payment number having a predetermined limit amount and a predetermined expiration date (see fig.7 element 706); associating the claim

identifier with the payment number (see col.3 lines 44-48); and transmitting the payment number to the merchant for payment of the claim (see fig.7 element 712).

Re claims 2, 3. Wells further discloses the method of claim 1, wherein the claim is for a service rendered (i.e., sale transaction – purchase and delivery, see fig.7

Re claim 4. Wells further discloses the method of claim 1, wherein receiving a request from a merchant for a payment associated with a claim further comprises, receiving an estimated cost of repair from the merchant (estimated cost of repair would inherently be included in the purchase order that need to be settled by the client, see fig.7 elements 704-707).

Re claim 5. Wells further discloses the method of claim 1, further comprising providing verification that the request received from the merchant is covered under a contract associated with the claimant (see col.3 line 57-col.4 line 11).

Re claim 6. Wells further discloses the method of claim 1, wherein generating a payment number having a predetermined limit amount and a predetermined expiration date further comprises: receiving an estimated cost of repair from the merchant (estimated cost of repair would inherently be included in the purchase order that need to be settled by the client, see fig.7 elements 704-707), and authorizing the predetermined limit amount (i.e., authorization see col.4 lines 1-15).

Re claim 7. Wells further discloses the method of claim 1, wherein generating the claim identifier further comprises; identifying a contract number assigned to a claimant; generating a claim number (see fig.7 element 704); and associating the claim number with the contract number (the account summary shown in fig.9 of Wells clearly shows how these generated

purchase order (claim number) are associated with the contract number (please see fig.9 of Wells).

Re claim 8. Wells further discloses the method of claim 1, further comprising after transmitting the payment number to the merchant for payment of the claim: tracking at least one merchant payment associated with the payment number; and associating the payment number and the claim identifier with the at least one merchant payment (i.e., In some embodiments, reversals or credits may also be tracked using features of the present invention. For example, if a merchant credits an account (e.g., for a returned item or the like), account management system 105 may operate to search for transactions associated with the limited use account identifier, the settled amount and/or with the merchant which are equivalent or near the amount of the credit. Once the original transaction is identified, the credit amount is associated with the original purchase order number and settlement details are provided to the client. In this manner, the client's accounting and/or purchasing systems can track purchases as well as returns or credits, see col.24 lines 12-30).

Re claim 9. Wells further discloses the method of claim 8, further comprising prior to tracking the at least one merchant payment: transmitting a merchant payment request; assigning an acceptance code to the merchant payment request; and associating the acceptance code with the merchant payment (see col.3 lines 42-65)

Re claim 10. Wells further discloses the method of claim 1, further comprising: requesting a load of funds equal to the predetermined limit amount; executing the load of funds; generating a confirmation of the load of funds execution; and reconciling the payment number and the claim identifier with the confirmation of the load of funds execution (see fig.7 element 722).

Re claims 11, 12-15. Wells further discloses the method of claim 1, wherein generating a payment number having a predetermined limit amount and a predetermined expiration date, further comprises selecting the payment number from a predetermined group of payment numbers (see col.3 lines 35-55).

Re claim 16. Wells further discloses a method of paying a merchant for a claim service provided to a claimant, the method comprising the steps of: receiving a request from a merchant for a payment associated with a claim (see fig.7 element 702, i.e., selection of merchant and item to be purchase is inherently followed by a request from a merchant for a payment), the request further comprising an estimate for repair; verifying that the request received from the merchant is covered under a contract associated with the claimant (see col.3 line 57-col.4 line 11); establishing a predetermined limit amount for the repair (see fig.7 element 706); generating a claim identifier (see fig.7 element 704); selecting a payment number (see col.3 lines 35-55), the selected payment number having the predetermined limit amount and a predetermined expiration date (see fig.7 element 706); associating the claim identifier with the selected payment number (see col.3 line 44-48); transmitting the payment number to the merchant for payment of the claim (see fig.7 element 712); providing funding for the predetermined limit amount associated with the selected payment number; tracking a transaction amount associated with the selected payment number (see col.13 lines 6-11); and reconciling the payment number and the claim identifier with the transaction amount (see col.9 lines 40-50, also see col.3 line 57-col.4 line 11).

Re claim 17. Wells further discloses the method of claim 16, wherein tracking a transaction amount further comprises, tracking a plurality of transaction amounts and reconciling the

payment number and the claim identifier with the plurality of transaction amounts (see fig.7-fig.9).

### *Response to Arguments*

Applicant's arguments filed on 04/14/08 have been fully considered but they are not persuasive. The applicant argues in substance that, in Wells, it is the client that is "transmitting the payment number to the merchant for payment of the claim." However, in applicant's system the payment number is transmitted to the merchant by the system based upon the prior interaction between the merchant and the issuer/facilitator and the steps emanating from the issuer (not the client in transmitting payment). The examiner contends that the limitation (i.e., the payment number is transmitted to the merchant by the system based upon the prior interaction between the merchant and the issuer/facilitator and the steps emanating from the issuer) being contested by the applicant is not in the claim. The examiner advises that if the applicant recognizes inventive features, in his claimed invention, that further avoid the prior arts, the applicant needs to amend the claim to recite these features. Thus, it is not enough for the applicant to distinguish his claimed invention from the prior art by pointing out what is disclosed in the specification but not recited in the claim. The examiner wants to remind the applicant that even though claims are interpreted in light of the specification, the specification must not be read into the claim.

The applicant further argues that Wells fail to disclose "receiving an estimated cost of repair from the merchant; and authorizing the predetermined limit amount." Contrary to the applicant's assertion, the examiner contends that estimated cost of



repair would inherently be included in the purchase order that need to be settled by the client, see fig.7 elements 704-707 of Wells. Wells further discloses authorizing the predetermined limit amount (i.e., transaction amount authorization, see col.3 line 56-col.4 line 10).

The applicant further argues that Wells fails to disclose generating a claim number; and associating the claim number with the contract number. Contrary to the applicant's assertion, Wells discloses generating a purchase order (see fig.7 element 704) which is akin to the claim number mentioned by the applicant. And the account summary shown in fig.9 of Wells clearly shows how these generated purchase order (claim number) are associated with the contract number (please see fig.9 of Wells).

The applicant further argues that Wells fails to teach tracking at least one merchant payment associated with the payment number; and associating the payment number and the claim identifier with the at least one merchant payment. Contrary to the applicant's assertion, Wells makes this disclosure (i.e., In some embodiments, reversals or credits may also be tracked using features of the present invention. For example, if a merchant credits an account (e.g., for a returned item or the like), account management system 105 may operate to search for transactions associated with the limited use account identifier, the settled amount and/or with the merchant which are equivalent or near the amount of the credit. Once the original transaction is identified, the credit amount is associated with the original purchase order number and settlement details are provided to the client. In this manner, the client's accounting and/or purchasing systems can track purchases as well as returns or credits, see col.24 lines 12-30).

The applicant lastly argues that Wells fail to disclose requesting a load of funds equal to the predetermined limit amount. Contrary to the applicant's assertion, Wells discloses requesting pre-authorization to receive limited use account identifier for purchasing the selected items. The limited use account, as the name suggests, has a predetermined limit amount that can be used for purchasing the selected item. Thus, requesting pre-authorization to receive limited use account identifier for purchasing the selected items, as taught by Wells, is akin to requesting a load of funds equal to the predetermined limit amount.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to OJO O. OYEBISI whose telephone number is (571)272-8298. The examiner can normally be reached on 8:30A.M-5:30P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Dixon can be reached on (571)272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ella Colbert/  
Primary Examiner, Art Unit 3696

/O. O. O./

<div>Application Number</div> <div></div>	Application/Control No.	Applicant(s)/Patent under Reexamination	
	10/708,247	ALLEN ET AL.	
	Examiner	Art Unit	
	OJO O. OYEBISI	3696	